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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,593	08/27/2003	Robert Donald Villwock	85639.7	4983

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EXAMINER

PAHNG, JASON Y

ART UNIT PAPER NUMBER

3725

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/649,593

Applicant(s)

VILLWOCK ET AL.

Examiner

Jason Y. Pahng

Art Unit

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 24-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 24-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings are informal and reference characters are not legible. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Objections

The amendment overcomes the claim objections made in the last Office action.

Claims 1, 15, and 24 are objected to because of the following informalities:

With regard to claim 1, line 7, the word "further" should be deleted because the two steps have not been previously defined.

With regard to claim 15, it is not clear whether "a first input" (line 3 and 4) as claimed is the same as one of the two inputs (line 3) as claimed. It is also not clear whether "wherein an input" (line 5) as claimed is the same as "having an input" (line 5) as claimed.

With regard to claim 24, line 7, the word "further" should be deleted because the two steps have not been previously defined.

Claim Rejections - 35 USC § 112

The amendment overcomes the claim rejections under 35 U.S.C. 112 made in the last Office action.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear whether "a grinding step" in line 3 as claimed is the same grinding step as claimed in the preceding claims. It is also not clear whether "a separation step" in line 5 as claimed is the same sifting step as claimed in the preceding claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 10-17, and 24-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner et al. (US 5,669,559) in view of Prosser et al. (US 3,687,699).

With regard to claims 1, 10, 11, and 24, Wagner discloses a process for forming powders by comminuting polyurethane containing materials including:

1. chopping polyurethane containing materials to produce a polyurethane containing flock (column 3, lines 4-6);
2. processing further said polyurethane containing flock through an input of a comminuting process having an output; and
3. the comminuting process comprises a grinding step (4) and sifting step (10).

Wagner does not disclose adding hydrous silicate. In a closely related art pertinent to the problem, Prosser discloses a process for forming powders by comminuting tacky elastomeric materials such as elastomeric polymers (column 2, lines 15-24) by adding a dusting agent such as talc or hydrous silicate (column 3, lines 5-15) in order to reduce agglomeration (column 1, lines 30-40). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide Wagner with a dusting agent such as talc or hydrous silicate for comminuting polyurethane, in order to reduce agglomeration, as taught by Prosser.

Prosser also discloses shearing elastomeric materials such as elastomeric polymers (column 2, lines 15-24) instead of milling in order to reduce agglomeration (column 1, lines 30-40). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide Wagner with shearing elastomeric materials such as elastomeric polymers instead of milling in order to reduce agglomeration, as taught by Prosser.

With regard to claims 2 and 25, Wagner discloses comminuting a foamed material (column 5, lines 1 and 2).

Claims 3-5 and 26-28 recite adding hydrous silicate at various stages of the comminution process. Prosser discloses that dusting agent can be blown into the vicinity of the cutting action or otherwise caused to make contact with the tacky material, uniform distribution on the freshly cut surfaces of the tacky material particles being the objective (column 3, lines 22-26). It would have been an obvious matter of design choice to add hydrous silicate at various stages of the comminution process, since Applicant has not disclosed that the particular location of addition of the hydrous silicate solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the process of Prosser. Since Applicant has not presented any arguments, adding hydrous silicate at various stages of comminution process will be considered an admitted prior art in the future Office actions.

With regard to claims 6 and 29, Prosser's talc or hydrous silicate is less than 45 micron or 325 mesh size (column 3, lines 5-15).

With regard to claims 7 and 30, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use hydrous silicate with a size in the range of approximately 0.2 mm to 5 mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Furthermore, a size of 45 micron would work equally well as disclosed by Applicant in claims 6 and 29. Since Applicant has not presented any arguments, using hydrous

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silicate with a size in the range of approximately 0.2 mm to 5 mm will be considered an admitted prior art in the future Office actions.

With regard to claims 12-14 and 31-33, Prosser's talc or hydrous silicate is added in the amount of approximately between 2 % and 10 % by weight (column 3, lines 16-17).

With regard to claims 15 and 34, Wagner discloses a grinding step with two inputs (1 and 7) and an output (6), and a separation step (10) having an input and two outputs (13 and 14).

With regard to claims 16 and 35, Wagner discloses a conveying step (9 and 12). The use of conveying system is also disclosed in the specification (page 4) and is Applicant's Admitted Prior Art (AAPA).

With regard to claims 17 and 36, Wagner discloses a separating step (10) comprising at least one screen (column 3, line 13-15). The use of a screen is also disclosed in the specification (page 5) and is Applicant's Admitted Prior Art (AAPA).

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner et al. (US 5,669,559) in view of Prosser et al. (US 3,687,699), further in view of Benn et al. (US 4,157,790). Claims 8 and 9 call for a solid additive chosen from a group including carbon black. In a closely related art, Benn discloses a process for pulverizing rubber with the use of a solid additive, carbon black (column 3, lines 19-22), in order to reduce agglomeration (column 1, lines 11-19). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide Wagner (as

modified by Prosser) with a dusting agent such as carbon black for pulverizing polyurethane, in order to reduce agglomeration, as taught by Benn.

Response to Arguments

Applicant's arguments filed August 22, 2005 have been fully considered but they are not persuasive.

Applicant argues that Wagner and Prosser are not combinable because Prosser teaches away from Wagner. This is not true. Prosser does not teach away from Wagner. Prosser merely improves Wagner in two ways. Prosser uses shearing action in order to reduce agglomeration and Prosser uses talc or hydrous silicate in order to reduce agglomeration.

It is noted that the claimed limitations do not exclude shearing action. Furthermore, the claimed limitations do not recite how fine the fine particles should be.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

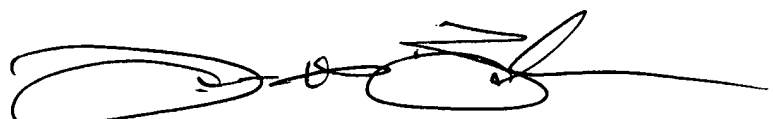
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Y. Pahng whose telephone number is 571 272 4522. The examiner can normally be reached on 9:00 AM - 7:00 PM, Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571 272 4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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